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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,052	02/16/2000	Donald R. Russell	P96005US2B	6415

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EXAMINER

HORTON, YVONNE MICHELE

ART UNIT PAPER NUMBER

3635

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/505,052

Applicant(s)

RUSSELL ET AL.

Examiner

Yvonne M. Horton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-8,10-19,21-24 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-8,10-19,21-24 and 27-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 6-7, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,563,217 to DAVIS et al. DAVIS et al. discloses a method for applying a walkway pad, column 17, line 4, to a roofing membrane (2) or roof, column 13, line 62-67 including the steps of affixing an adhesive tape (5), column 12, line 18-20, having a protective layer (6); removing the release paper (60, column 12, line 20; placing the exposed surface of the tape (5) on the membrane; and applying a force, column 12, lines 21 and 42-44. Regarding claims 2 and 4, the walkway pad is rubber-based, column 3, lines 54-55, wherein the walkway pad includes a blend of EPDM and butyl rubbers, column 3, lines 49-50, column 4, line 13, and column 6, line 14. In reference to claim 3, the tape (5) includes EPDM, column 3, lines 49-55. Regarding claims 6 and 7, the method of DAVIS et al. further includes an additional step of preparing the roofing area, column 10, line 34-35; wherein the preparing step includes priming prior to removing the release paper (6). In reference to claim 32, the walkway pad is rubber-based, column 3, lines 53-56. Regarding claim 33, roofing membrane is rubber-based, column 3, lines 49-50.

Claims 8, 10-15 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,563,217 to DAVIS et al. DAVIS et al. discloses a method for applying

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a walkway pad, column 17, line 4, to a roofing membrane (2) or roof, column 13, line 62-67 including the steps of providing a walkway pad including an adhesive tape (5), column 12, line 18-20, having a protective layer (6). Regarding claims 10 and 12, the walkway pad is rubber-based, column 3, lines 54-55, wherein the walkway pad includes a blend of EPDM and butyl rubbers, column 3, lines 49-50, column 4, line 13, and column 6, line 14. In reference to claim 11, the tape (5) includes EPDM, column 3, lines 49-55. Regarding claims 13 and 15, the method of DAVIS et al. further includes an additional step of preparing the roofing area, column 10, line 34-35; wherein the preparing step includes without priming prior to removing the release paper (6), column 10, lines 34-35 and 38-40, for instance, "if desired". In reference to claim 14, the tape (5) is applied to a flat surface of the walkway pad where the pad is manufactured. Regarding claim 24, the method further includes removing the release paper (6), column 12, line 20.

Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,563,217 to DAVIS et al. DAVIS et al. discloses the method of making a walkway pad including constructing the pad in a factory, applying an adhesive (5), applying a release paper (6) also at the factory.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 16-19 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over DAVIS et al. DAVIS et al. discloses the method of providing a walkway pad including the step of preparing a self-adhering pad by affixing a tape (8) having a release paper (6). DAVIS et al. discloses the basic claimed method except for explicitly detailing the steps of bundling or delivering. Although DAVIS et al. is silent in this regard, it would have been obvious to one having ordinary skill in the art that the method of DAVIS et al. inherently includes bundling and delivering. Regarding claims 17 and 19, the walkway pad is rubber-based, column 3, lines 54-55, wherein the walkway pad includes a blend of EPDM and butyl rubbers, column 3, lines 49-50, column 4, line 13, and column 6, line 14. In reference to claims 18 and 23, the tape (5) includes EPDM, column 3, lines 49-55 and is 100% solid. Regarding claim 22, the method of DAVIS et al. further includes an additional step of preparing the roofing area, column 10, line 34-35; wherein the preparing step includes without priming prior to removing the release paper (6), column 10, lines 34-35 and 38-40, for instance, "if desired". In reference to claim 21, the tape (5) is applied to a flat surface of the walkway pad where the pad is manufactured.

Claims 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,563,217 to DAVIS et al. DAVIS et al. discloses the basic claimed method except for explicitly detailing the thickness of the walkway pads or except for explicitly detailing if the pad is textured. Regarding claim 28, DAVIS et al. does not specifically disclose 30 square inches; however, he does detail 24 square inches. However, 24 is "about" 30 inches. It would have been obvious to one having ordinary skill in the art at

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the time the invention was made to specify a pad thickness suitable for the use intended as an obvious matter of design choice. In reference to claim 31, DAVIS et al. does not detail a textured walkway pad per se'; however, it is inherent that conventional walkway pads have a texture. Even so, it would have been obvious to one having ordinary skill in the art to texture the material in order to improve adhesion of the tape to the walkway pads.

Response to Arguments

Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (703) 308-1909. The examiner can normally be reached on 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (703) 308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YMH

April 30 2004